

REMARKS

Claims 1-47 are pending with this paper. Claims 9-11 and 19-28 are withdrawn from consideration. Claims 1, 3, 12, 15, 16, 18, and 29-38 are rejected and 2, 4-8, 13, 14, and 17 are objected to. The Applicant has added new claims 39-47. No new matter has been introduced into the application. Applicant is respectfully responding to the Final Office Action dated August 23, 2004 and the comments made in the Advisory Office Action dated December 13, 2004. The Applicant notes that some of the arguments presented below have been presented in the Amendment and Response to the Final Office Action filed November 16, 2004. Applicant has included additional remarks directly responsive to the Final Office Action and Advisory Office Action.

Rejections under 35 U.S.C. §103

Claims 1, 3, 33, 34, 35, 36, 37, and 38 stand rejected under 35 USC §103(a) as being unpatentable over Nappholz et al. (US Patent 5,188,106) in view of Wojcicki et al. (US Patent 5,190,522). Applicant respectfully traverses the rejection.

With regard to independent claim 1, both Nappholz and Wojcicki fail to disclose, teach, or suggest the claimed feature of:

b) a telemetry module providing bi-directional communication between the computing device and the implantable drug delivery device and providing the pump performance acquisition instructions to the implantable drug delivery device”

The Office Action attempts to equate the telemetry block 103 shown in Figure 10 of Nappholz with the claimed feature of “a telemetry module providing bi-directional communication . . . and providing the pump performance acquisition instructions” (Emphasis added). Applicant respectfully submits that the telemetry block 103 of Nappholz does not disclose, teach, or suggest the claimed feature.

Regarding telemetry block 103 of Figure 10, Nappholz discloses:

All device logic is under the control of a controller 100 (which may be a microprocessor). **The controller operates various switches to control:** (1) the enabling or disabling of intrinsic (or natural) cardiac activity sensing in the atrium (ASENSE) and the ventricle (VSENSE) of the heart by means of control signals communicated to a sensing and depolarization controller 115; (2) the generation of stimulating pulses in the atrium (APACE) and the ventricle (VPACE) by means of control signals extending to an output generator block 102; (3) timers 101; (4)

intracardiac electrogram sensing in the atrium (AECG) and ventricle (VECG) by means of control signals communicated to an A/D converter 120; (5) Doppler signal sensing by means of control signals sent to a Doppler signal processor 70; and (6) **telemetry block 103**.

(Col. 18, line 65 – col. 19, line 12. Emphasis added.).

The cited section of Nappholz does not disclose the claimed telemetry module of Applicant's invention. Nappholz merely teaches that a telemetry block 103 is controlled by controller 100. The controller 100 reads sensing data from sensing and polarization controller 115. While controller 100 reads sensing data from polarization controller 115, Nappholz does not disclose or suggest that telemetry block 103 provides pump performance acquisition instructions to controller 100.

Moreover, Applicant agrees with the Office Action that Wojcicki does not disclose a telemetry module. (Office Action, Page 4). Consequently, the combination of Nappholz and Wojcicki does not disclose, teach, or suggest the claimed feature of "a telemetry module providing bi-directional communication . . . and providing the pump performance acquisition instructions" (Emphasis added). Claims 3, 33, 34, 35, 36, 37, and 38 which ultimately depend from claim 1 are allowable for at least the same reason as independent claim 1.

In an Advisory Action dated December 13, 2004, the Action states:

Applicant's arguments filed 11/16/2004 have been considered but they are not persuasive. In response to applicant's arguments against the references individually (lacking of 'telemetry module providing bi-directional communication.... and providing the pump performance acquisition instruction...'), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d. 1091, 231 USPQ 375 (Fed. Cir. 1986).

Advisory Office Action, Page 2.

Applicant respectfully disagrees with the Examiner as when evaluating patentability under 35 U.S.C. § 103(a), all claim limitations must be considered, especially when missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because, *inter alia*, the examiner ignored a claimed limitation which was absent from the reference). Applicant respectfully submits that the cited section of Nappholz does not disclose the claimed telemetry module of Applicant's invention. Moreover, Applicant agrees with the Office Action that Wojcicki does not disclose a telemetry module. (Office Action,

Page 4). Applicant is not trying “to show nonobviousness by attacking references individually where the rejections are based on combinations of references.” (Advisory Office Action, Page 2). In contrast, Applicant is stating that Nappholz, Wojcicki, nor their combination do not disclose, teach or suggest the claimed feature of “a telemetry module providing bi-directional communication . . . and providing the pump performance acquisition instructions” In other words, a *prima facie* obviousness case of the claimed invention has not been presented by the Examiner. Therefore, for at least this reason claim 1 is in condition for allowance.

Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wojcicki in view of Nappholz. As will be discussed, claim 12 as currently amended is not taught by Wojcicki. Moreover, Nappholz does not make up for the deficiencies of Wojcicki. Because claims 15 and 18 depend from claim 12, claims 15 and 18 are patentable over Wojcicki and Nappholz.

Rejections under 35 U.S.C. §102

Claims 12, 16, 29, 30, 31, and 32 stand rejected under 35 USC §102(b) as being anticipated by Wojcicki, et al. (US Patent 5,190,522). The Applicant has amended claim 12 to include the feature “a telemetry module that receives the performance acquisition instructions, the performance acquisition instructions being stored in the memory.” The amendment is supported by the specification (e.g., Figures 8 and 9 and Paragraphs 48-50) as originally filed. Applicant respectfully submits that Wojcicki does not teach or even suggest this feature. Claim 16 which depends from claim 12 is allowable for at least the same reason as claim 12. Moreover, claim 14 has been amended into independent form. It is respectfully submitted that claims 29-32 which ultimately depend from claim 14 are in condition for allowance for at least the same reason as claim currently amended claim 14.

Allowable Subject Matter

Claims 2, 4-8, 13, 14, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicant has rewritten claims 13, 14, and 17 to be in independent

form including all the limitations of the base claim and any intervening claims. Thus, Applicant respectfully submits that claims 13, 24, and 17 are allowable as currently amended.

Applicant has added new claims 39-47, which ultimately depend from claims 13, 14, and 17. Applicant respectfully submits that newly added claims 39-47 are allowable for at least the same reason as claims 13, 14, and 17.

Applicant respectfully submits that the instant application is in condition for allowance. Should the Examiner believe that a conversation with Applicant's representative would be useful in the prosecution of this case, the Examiner is invited and encouraged to call Applicant's representative.

Respectfully submitted,

Dated: February 14, 2005

By: _____


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